

21



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/604,985	08/29/2003	Itzhak Bentwich	05-0007#11/cat	1984
37808	7590	06/20/2005	EXAMINER	
ROSETTA-GENOMICS			ASHEN, JON BENJAMIN	
10 PLAUT-STREET SCIENCE PARK				
P.O. BOX 2061			ART UNIT	
REHOVOT, 76706			PAPER NUMBER	
ISRAEL			1635	

DATE MAILED: 06/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/604,985

Applicant(s)

BENTWICH, ITZHAK

Examiner

Jon B. Ashen

Art Unit

1635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to:
- 8) ☒ Claim(s) 1-16 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input checked="" type="checkbox"/> Other: <u>Revised Notice to Comply</u> . |

DETAILED ACTION

Objections to the Specification

Sequence Compliance

1. The disclosure is objected to because of the following: This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the reason(s) set forth below or on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures. The specification as filed does not comply with the requirements above, in particular 1.821(d) at least, because it contains nucleotide sequences of over 10 nucleobases each that are not identified by accompanying sequence identifiers. Specifically, pages 77 and 79 and figures 21, 22 and 23 contain nucleotide sequences that are depicted without accompanying SEQ ID NOs:.

2. It is noted herein that the above listing of pages and figures which set forth examples in the specification of nucleotide sequences that require SEQ ID NO: is by way of illustration. In order to be fully responsive to this Office Action, Applicant should review this application in its entirety to ensure compliance with the requirements of 37 CFR 1.821 through 1.825 and to make all appropriate corrections.

Election/Restrictions

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Art Unit: 1635

- I. Claims 1-10, 13-14 and 16 drawn to a bioinformatically detectable novel gene, a probe comprising said novel gene, a vector comprising said novel gene, a kit comprising said vector and a vector inserter and a kit comprising said probe and a gene expression detector, classifiable in class 536, subclass 24.5.
- II. Claims 11 and 12, drawn to a method of inhibiting translation of at least one gene comprising introducing the vector of claim 10 into a cell, classifiable in class 514, subclass 44.
- III. Claim 15, drawn to a method of detecting gene expression using a DNA probe that comprises a bioinformatically detectable novel gene, classifiable in class 436, subclass 6.

The inventions are distinct, each from the other because of the following reasons:

4. Group I and Group II and III are related as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). Group I is drawn to a nucleic acid product that is a bioinformatically detectable novel gene including vectors and kits thereof. Group II and III are drawn to methods of using the nucleic acid product of

Art Unit: 1635

Group I. Group II is drawn to and reads on a method of treatment and requires inhibition of at least one gene in a cell. Group III is drawn to an assay method of detecting gene expression. In the instant case, the product as claimed can be used in a materially different process of using that product. In regards to groups I and II, the product may be used in a method of hybridization, to detect gene expression. In regards to groups I and III, the product may be used in a method of inhibiting gene expression by inhibiting translation.

Furthermore, search and examination of Group I with either of Groups II or III would impose a serious and undue burden. In the instant case, prior art searches of methods of treatment (or of methods of inhibiting gene expression in vitro) and of methods of detecting gene expression would not be coextensive with a prior art search of the claimed compound(s). Search of each of these inventions would require different key word searches of each method that would necessarily include a search for the distinctive method steps of each that would be different for each and that would not be required in a search of the compound(s). These searches would have to be performed using divergent patent and non-patent literature databases. The different searches would then require subsequent in-depth analysis of the unrelated prior art literature, placing a serious and undue burden on the Office in terms of both search and examination. As such, it would be burdensome to perform search and examination of Group I with either of Groups II or III.

Group I is further restricted as follows.

5. Group I comprises claims to the following patentably distinct inventions. Group I comprises claims drawn to a bioinformatically detectable novel gene wherein the gene is a) required and b) not required, to encode a protein. Each of these compounds is patentably distinct because each are biologically, functionally, structurally and/or chemically distinct. In particular, the invention in Group I, b requires that the bioinformatically detectable novel gene does not encode a protein. The invention in Group I, a, can be a bioinformatically detectable novel gene that encodes a protein, which would be structurally and functionally different than the invention in Group I, b. One could not be substituted for the other with the expectation that the same result would be achieved. Additionally, a search of one of a or b would not be coextensive with a search of the other because the searches would require different key words to identify different bioinformatically detectable novel genes that do and do not encode proteins. If Applicant chooses to elect group I, the claims of the elected group will be examined insofar as they read on the elected subject matter that is identified above in a or b above.

6. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a

matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996).

Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Art Unit: 1635

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon B. Ashen whose telephone number is 571-272-2913. The examiner can normally be reached on 7:30 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, Andrew Wang can be reached on 571-272-0811. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file

Art Unit: 1635

folder(s) as well as general patent information available to the public. For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Jba

83 TC 1600

NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES

Applicant must file the items indicated below within the time period set the Office action to which the Notice is attached to avoid abandonment under 35 U.S.C. § 133 (extensions of time may be obtained under the provisions of 37 CFR 1.136(a)).

The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 C.F.R. 1.821 - 1.825 for the following reason(s):

- ☒ 1. This application clearly fails to comply with the requirements of 37 C.F.R. 1.821-1.825. Applicants attention is directed to the final rulemaking notice published at 55 FR 18230 (May 1, 1990), and 1114 OG 29 (May 15, 1990). If the effective filing date is on or after July 1, 1998, see the final rulemaking notice published at 63 FR 29620 (June 1, 1998) and 1211 OG 82 (June 23, 1998).
- ☐ 2. This application does not contain, as a separate part of the disclosure on paper copy, a ASequence Listing≡ as required by 37 C.F.R. 1.821(c).
- ☐ 3. A copy of the ASequence Listing≡ in computer readable form has not been submitted as required by 37 C.F.R. 1.821(e).
- ☐ 4. A copy of the Sequence Listing in computer readable form has been submitted. However, the content of the computer readable form does not comply with the requirements of 37 C.F.R. 1.822 and/or 1.823, as indicated on the attached copy of the marked -up Raw Sequence Listing.
- ☐ 5. The computer readable form that has been filed with this application has been found to be damaged and/or unreadable as indicated on the attached CRF Diskette Problem Report. A Substitute computer readable form must be submitted as required by 37 C.F.R. 1.825(d).
- ☐ 6. The paper copy of the ASequence Listing≡ is not the same as the computer readable from of the ASequence Listing≡ as required by 37 C.F.R. 1.821(e).
- ☒ 7. Other: Nucleotide sequences depicted in the specification without accompanying sequence identifiers as required by 1.821(d).

Applicant Must Provide:

- ☒ An initial or substitute computer readable form (CRF) copy of the Sequence Listing. (If the unidentified sequences are not provided on the CRF)
- ☒ An initial or substitute paper copy of the Sequence Listing, as well as an amendment directing its entry into the specification. (If the unidentified sequences are not provided in the paper copy)
- ☒ A statement that the content of the paper and computer readable copies are the same and, where applicable, include no new matter, as required by 37 C.F.R. 1.821(e) or 1.821(f) or 1.821(g) or 1.825(b) or 1.825(d). (If a new paper and/or CRF are required)

For questions regarding compliance to these requirements, please contact:

For Rules Interpretation, call (703) 308-4216

For CRF Submission Help, call (703) 308-4212

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